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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/926,246	09/05/1997	MICHAEL J SULLIVAN	SLD-2035-1-2	6680

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MICHELLE BUGBEE, ASSOCIATE PATENT COUNSEL
SPALDING SPORTS WORLDWIDE INC
425 MEADOW STREET
PO BOX 901
CHICOPEE, MA 01021-0901

EXAMINER

GRAHAM, MARK S

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/926,246

Applicant(s)
Sullivan

Examiner
Mark S. Graham

Art Unit
3711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 6, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The 08/070,510 application from which applicant claims priority for the claimed subject matter does not enable the claimed subject matter.

Each of the following has been identified by the examiner as non-enabled subject matter:

1. In claim 1, the lower limit on the core diameter (29 mm), the upper limit on the core specific gravity (1.4), the lower limit of the intermediate layer thickness (1 mm), the upper limit of the specific gravity of the intermediate layer (1.2), the lower limit of the hardness of the intermediate layer (85 on JIS C), and the upper limit of the thickness range of the cover being claimed (3 mm) are not enabled.

As an example the upper limit on the thickness range of the originally disclosed cover was 1.27 mm.

2. In claim 3, there is no basis provided for the applicant's reasoning that the now claimed hardness range of the cores and covers was inherent in the original disclosure. Without a basis in the original disclosure the now claimed ranges must be considered non-enabled.

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3. In claim 5, the lower limit of the diameter of the center core being claimed (29 mm) was not disclosed in the original disclosure. The lower limit originally disclosed was 35.052 mm.

4. In claim 6, neither the upper or lower limit of the claimed difference in the specific gravity (.5 - .1) was disclosed in the original disclosure. By applicant's admission the limits of the difference disclosed were (.234 - .164).

5. In claim 7, neither the upper limit (1.0) nor the lower limit (.9) were disclosed in the original disclosure. While values within that range were disclosed they do not make inherent the upper and lower bounds of the claimed range.

6. In claim 8, neither the upper limit (100) nor the lower limit (85) were disclosed in the original disclosure. While values within that range were disclosed they do not make inherent the upper and lower bounds of the claimed range.

Claims 1-8 of this application have been copied by the applicant from U. S. Patent No. 5,553,852. These claims are not patentable to the applicant because they are not enabled under 35 U.S.C. 112 1st paragraph.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

Because the earliest date from which the applicant can claim priority for the claimed subject matter is the filing date of the instant application the following rejection applies:

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Higuchi '043.

Applicant's arguments filed 9/6/02 have been fully considered but they are not persuasive.

Regarding the claim 1 rejection applicant is claiming a range from 29 mm to infinity. The lowest value the disclosure recites is 39.243 mm. The 39.243 mm value recited by the applicant is approximately 30% larger than the lower end of the claimed range and nothing in the specification indicates that applicant intended to include anything below 39.243 mm as opposed to other possibilities.

The same logic applies to the range of the specific gravity of the core between 1.4 and 1.155. Applicant has simply given no indication that specific gravities in this range were intended to be part of his invention among other possibilities.

Regarding the lower limit of the intermediate thickness, applicant is correct in that this was part of the original disclosure. However, applicant's disclosed ball is not inclusive of thicknesses above 2.54 mm whereas that being claimed is.

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Concerning the specific gravity of the intermediate layer, the disclosure is not inclusive of the range between 1.2 and .97 as is now being claimed.

With regard to the hardness of the intermediate layer, the originally disclosure is not inclusive of the range between 85 and 95.

Concerning the applicant's outer cover thickness, the largest cover thickness disclosed was 1.27 mm which is not even half of the now claimed 3 mm.

Regarding claim 3 arguments, the applicant has freely admitted that there would have been possibilities other than that which he now claims. Moreover, how would one know that applicant intended the entire range as opposed to only an upper end of the range?

Regarding the claim 5 arguments, applicant has provided no evidence that a lower limit of 29 mm was disclosed to the exclusion of other possibilities.

Regarding claim 6, applicant has still provided no evidence that values above .234 or below .164 were intended as is now claimed. Likewise with regard to claims 7 and 8, applicant has still provided no evidence that values as high as the upper end of the claimed ranges, or as low as the lower end of the claimed ranges were intended as is claimed. Thus, values such as these represent are not enabled. The values now being claimed are only one possibility among an infinite number that applicant might have intended.

In none of these instances could applicant's claimed subject matter be divined by routine experimentation for the routineer would simply have no way of knowing in what direction to experiment given that there is no suggestion of values outside those presented in the disclosure.

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Applicant's interpretation of the "undue experimentation" test is akin to stating that the ordinarily skilled artisan would, by routine experimentation without further evidence, determine that "2" included "3" but did not include "1". Such an interpretation is clearly illogical on its face.

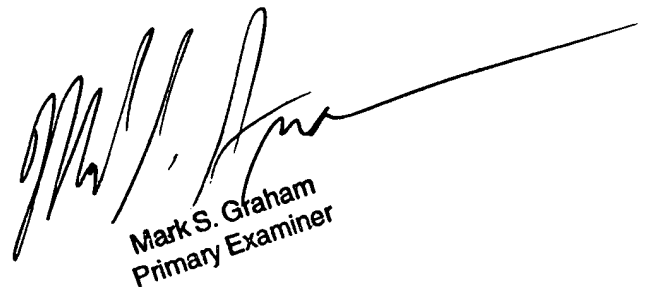
An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG
October 21, 2002



Mark S. Graham
Primary Examiner